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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
08 973,381	03 25 1998	NORMAND HEBERT	ISIS-2297	6836

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EXAMINER

MARSCHER, ARDIN H

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 06.17.2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/973,381

Applicant(s)

Hebert

Examiner

Ardin Marschel

Art Unit

1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136. a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704 b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 5, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-56 is/are pending in the application.

~~5) ☐ Claim(s) 1-30 have been canceled.~~ ~~6) ☐ Claim(s) 1-30 have been withdrawn from consideration.~~

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 31-56 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)                           | 4. <input type="checkbox"/> Interview Summary (PTO-413) Paper No. s. _____  |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)       | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3. <input type="checkbox"/> Information Disclosure Statement (PTO-1449) Paper No. s. _____ | 6. <input type="checkbox"/> Other: _____                                    |

Applicants' arguments, filed 2/5/03, have been considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### **VAGUENESS AND INDEFINITENESS**

Claims 39-44 and 51-56 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is reiterated and maintained from the previous office action, mailed 11/7/02.

Claim 51, line 1, directs the method to preparing a library which is reasonably interpreted as being a plurality of different entities therein which is in agreement with applicant's argument regarding the definition of what a combinatorial library is. The remainder of claim 51, after the word "comprising" in line 1 cites a series of steps which seem to be directed to the preparation of oligomeric compounds of aminodiol subunits which are cleaved from the support in the last step therein. Confusingly there are no limitations in these actual steps in claim 51 which are directed to what is normally thought of as a library preparation wherein the plurality of entities or polymers

therein at least include "different" polymers rather than all of the polymers being the same. The performance of the actual preparatory steps of claim 51 lacks any synthesis of different polymers requirement, however, it is acknowledged that optionally different polymers "may" be prepared via the actual claim steps. That is, the usage of a solid support upon which the preparation/synthesis of a single, non-different type of polymer of aminodiols subunits followed by cleavage is a reasonable interpretation of being included as practicing said preparatory steps. Thus, what is normally a library which is a mixture or plurality of different polymers is not per se required in the preparatory steps of claim 51. Thus, the metes and bounds of claim 51 are different if controlled by the preamble versus the actual preparatory steps in the claim. The preamble requires "different" polymers in the prepared library whereas the actual claim steps are inclusive of such a "different" polymer library, but also the preparation of a single pure polymer type. Which part of claim 51 controls the metes and bounds of the claimed method? Clarification via clearer claim wording is requested. Claims 52-56 are included in this rejection because none of them require at least a different polymer or library preparatory step either. Additionally, the library claims 39-44 are rejected also as being unclear for the same issue that there are no claim limitations therein that require the claimed library to contain

at least some different polymers. Applicant's arguments that the claims recite "six different" aminodiol monomer subunit structures does not preclude the selection of only one and the same monomer at each monomer preparatory step to form an oligomeric compound. Each list of said six different monomers contains the limitation "or" and nowhere in the claim is there any limitation that at least two or more "different" oligomeric compounds are made. In summary, the metes and bounds of the preamble (library of different compounds) and the actual claim steps (library of different compounds "or" a single pure oligomeric compound) preparation.

#### OBVIOUSNESS-TYPE DOUBLE PATENTING

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and <sup>§</sup> may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31-44 are rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,184,389.

This rejection is reiterated and maintained from the previous office action, mailed 11/7/02. This rejection is maintained as not being argued.

Claims 45-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,184,389 in view of either of Letsinger et al. (U.S. Patent No. 5,112,962) or Smith et al. (U.S. Patent 5,015,733).

This rejection is reiterated and maintained from the previous office action, mailed 11/7/02. This rejection is maintained as not being argued.

Claims 31-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 and 50-54 of U.S. Patent No. 6,448,373.

This rejection is reiterated and maintained from the previous office action, mailed 11/7/02. Applicant argues that there has not been any suggestion or motivation for the preparation of compounds within the instantly rejected claims that would thus satisfy an obviousness-type basis for rejection. In response applicant is referred to the previous office action where specific compounds were pointed out as species of

overlapping compounds between the instant claims as well as the claims of the cited Patent. It is also noted that for obviousness rejection bases that generic claims are deemed to motivate as well as suggest specifically cited species therein.

Alternatively, claims 31-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 6,448,373 in view of either of Letsinger et al. (U.S. Patent No. 5,112,962) or Smith et al. (U.S. Patent 5,015,733).

This rejection is reiterated and maintained from the previous office action, mailed 11/7/02. Applicant argues that there has not been any suggestion or motivation for the preparation of compounds within the instantly rejected claims that would thus satisfy an obviousness-type basis for rejection. In response applicant is referred to the previous office action where specific compounds were pointed out as species of overlapping compounds between the instant claims as well as the claims of the cited Patents. It is also noted that for obviousness rejection bases that generic claims are deemed to motivate as well as suggest specifically cited species therein.

Claims 31-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 5,886,177.

This rejection is reiterated and maintained from the

previous office action, mailed 11/7/02. Applicant argues that there has not been any suggestion or motivation for the preparation of compounds within the instantly rejected claims that would thus satisfy an obviousness-type basis for rejection. In response applicant is referred to the previous office action where specific compounds were pointed out as species of overlapping compounds between the instant claims as well as the claims of the cited Patent. It is also noted that for obviousness rejection bases that generic claims are deemed to motivate as well as suggest specifically cited species therein.

Claims 45-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 5,886,177 in view of either of Letsinger et al. (U.S. Patent No. 5,112,962) or Smith et al. (U.S. Patent 5,015,733).

This rejection is reiterated and maintained from the previous office action, mailed 11/7/02. Applicant argues that there has not been any suggestion or motivation for the preparation of compounds within the instantly rejected claims that would thus satisfy an obviousness-type basis for rejection. In response applicant is referred to the previous office action where specific compounds were pointed out as species of overlapping compounds between the instant claims as well as the claims of the cited Patents. It is also noted that for



obviousness rejection bases that generic claims are deemed to motivate as well as suggest specifically cited species therein.

#### OBVIOUSNESS PRIOR ART REJECTIONS

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-38 and 45-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hebert (P/N 6,448,373), taken alone, or alternatively, taken in view of either of Smith et al. (P/N 5,015,733) or Letsinger et al. (P/N 5,112,962).

This rejection is based on the different inventorship for Hebert (P/N 6,448,373) versus the instant application and applied for the same subject matter reasons as set forth above in the obviousness-type double patenting rejections.

This rejection is reiterated and maintained from the previous office action, mailed 11/7/02. Applicant argues that there has not been any suggestion or motivation for the preparation of compounds within the instantly rejected claims that would thus satisfy an obviousness-type basis for rejection.

In response applicant is referred to the previous office action where specific compounds were pointed out as species of overlapping compounds between the instant claims as well as the claims of the cited Patent(s). It is also noted that for obviousness rejection bases that generic claims are deemed to motivate as well as suggest specifically cited species therein.

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703)308-0196.

June 13, 2003

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